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REMARKS

Claims 1 to 11, 13, 14, 21 to 33, 35, 36, and 43 to 50 are pending in the present application. Claim 46 has been amended and support for the amendment may be found on page 15, lines 23-24. Reconsideration and allowance of the claims is respectfully requested in view of the following remarks.

Claim Rejections Under 35 U.S.C. § 112, second paragraph

Claims 46 to 49 stand rejected under 35 U.S.C. § 112, second paragraph for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In particular, the Examiner has indicated that the type of % used with regard to the amount of ester units was indefinite. Applicants have amended claim 46 to include this information. Accordingly Applicants request withdrawal of this rejection.

Claim Rejections Under 35 U.S.C. § 103(a)

Claims 1-9, 12, 14, 21-31, 35, 36, and 43-50 stand rejected under 35 U.S.C. § 103(a), as allegedly unpatentable over U.S. Patent No. 5,852,085 to Brown et al. (hereinafter referred to as "Brown") in view of U.S. Patent No. 5,391,594 to Romenesko et al. (hereinafter referred to as "Romenesko"). The Examiner has asserted that one of ordinary skill in the art would have been motivated by the teachings of Romenesko to add the silicone rubber powder taught therein to the thermoplastic composition of Brown in an effort to obtain the known benefits and improvements. Applicants respectfully traverse this rejection.

Brown discloses "thermoplastic compositions" which meet the long felt need for transparent articles. (Col. 2, lines 11-12) The transparent composition comprises a polyetherimide resin, at least one resin selected from the group consisting of polycarbonate resins, poly(ester-carbonate) resins, and polyarylate resins, and an effective amount of a catalyst to provide transparency to the composition. The required inclusion of the catalyst emphasizes the desire for transparency. Brown does not teach or suggest the inclusion of a polysiloxane. Brown does suggest the composition may be modified, at the expense of transparency, in order to gain some other property advantage. Among the list of these

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contains no suggestion as to which of the many available flame retardants might be successfully used in the composition. As a brief purview of the polymer art will suggest there is a wide range of flame retardants available for use and they may be employed with varying levels of success depending upon the composition. Brown gives no guidance as to the selection of the flame retardant.

Romenesko discloses a free-flowing silicone polymer powder prepared by mixing a polydiorganosiloxane with a silica filler. The silicone polymer powder may be dispersed in an organic resin and improve the burn character of the resin. (Abstract) Exemplary organic resins include thermosetting polyimides and thermoplastic polycarbonates. (Col. 4, line 53 to Col. 5, line 2) Romenesko does not teach or suggest the use of the silicone polymer powder with a thermoplastic polyester carbonate or a thermoplastic polyimide, let alone a combination of thermoplastic polyestercarbonate and thermoplastic polyimide as is instantly claimed.

For an obviousness rejection to be proper, the Examiner must meet the burden of establishing that all elements of the invention are disclosed in the prior art; that the prior art relied upon, coupled with knowledge generally available in the art at the time of the invention, must contain some suggestion or incentive that would have motivated the skilled artisan to modify a reference or combined references; and that the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988); *In Re Wilson*, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970); *Amgen v. Chugai Pharmaceuticals Co.*, 927 U.S.P.Q.2d, 1016, 1023 (Fed. Cir. 1996).

Applicants respectfully assert that there is no motivation in the art or reasonable expectation of success for the proposed modification of the prior art, namely the use of the silicone polymer powder of Romenesko in the composition of Brown. Brown's suggestion for the inclusion of a flame retardant is inadequate guidance for the selection of silicone polymer powder disclosed by Romenesko out of the wide range of disclosed flame retardants, the selection of which may have been guided by the use of impermissible hindsight on the part of the Examiner. Romenesko suggests the use of the silicone polymer powder in thermoplastic polycarbonate and thermosetting polyimide but does not teach or suggest its

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use in a composition of thermoplastic polyester carbonate, thermoplastic polyimide or combination thereof. Romenesko cannot be relied upon to provide motivation for the combination of the two references.

Based on the foregoing remarks, Applicants respectfully assert that a prima facie case of obviousness has not been made and the rejection should be withdrawn.

It is believed that the foregoing amendments and remarks fully comply with the Office Action and that the claims herein should now be allowable to Applicants. Accordingly, reconsideration and allowance is requested.

If there are any additional charges with respect to this Amendment or otherwise, please charge them to Deposit Account No. 07-0862.

Respectfully submitted,

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